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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/458,415    12/10/99    GILLESPIE

K    06129-156001 9

EXAMINER

QM12/0606

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STASHICK, A

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

06/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/458,415

Applicant(s)

GILLESPIE, KEVIN

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 47-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 47-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

- ✓
1. Applicant's election without traverse of Group I and Group VI in Paper No. 8 is acknowledged.

***Oath/Declaration***

- ✓
2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference T as recited on page 3, line 24; reference number 27 not in Figures as recited on page 4, line 1; reference d<sub>3</sub> is not in the Figures as recited on page 4, line 2; reference d<sub>4</sub> is not in the Figures as recited on page 4, line 28; reference number 68 is not located in the Figures as recited on page 5, line 21. Correction is required.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference numbers 54', as shown in Figure 3, and reference number 14, as shown in Figure 1 are not recited in the specification. Correction is required.

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*Specification*

6. The disclosure is objected to because of the following informalities: reference number 27 was defined as "the forward edge of the most forward groove" on page 4, line 1 then later, on page 4, lines 27-28, reference number 39 was referred to as the same. Reference number 37 was defined as "upper backfoot region" on page 5, line 3 then later referred to as "additional grooves" on page 5, lines 3-5. Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 6, 7, 47, 60, 66, 74 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claims 4, 6 and 7, the phrase "the shoe outsole." at the end of each claim renders the claim vague and indefinite. It is unclear as to how the inner member, a portion of the outsole, extends away from itself. It appears that the applicant meant to place the words --outer member-- at the end of the claims to refer to the inner member's relationship to the outer edge of the outer member of the sole. With respect to claims 47 and 76, the use of the phrase "an intermediate member" in line 2 of each claim renders the claims vague and indefinite. It is not clear whether the applicant is referring to a member between the toe and heel of the outer member or whether the applicant is referring to a member between a the upper and lower surfaces of the outer member. If applicant is referring to the "intermediate" member being located between the toe and heel of the outer member, words to that effect should be added to the claim to clarify it so that the metes and bounds of the claim can be determined. In regards to claims 60, 66 and 74, the use of the phrase "the

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member” in line 1 of each of the claims renders the claims vague and indefinite. It is not clear as to which member the applicant is referring to, the inner or outer member, as both are recited in claim 1 from which both depend. With respect to claim 76, it appears that the claim contradicts itself. The intermediate member is said to be part of the ground contacting surface, which is part of the inner member. Therefore, the inner member includes the intermediate member. If the intermediate member is part of the inner member, it is unclear how the inner member can be softer than the intermediate member, since the intermediate member is inclusive therewith.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat 6,092,251. Tomat '251 discloses all the limitations of the claims including the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7);

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intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Patterson et al. 6,176,025. The reference as applied to claim 1 above discloses all the limitations of the claims except for the inner member containing liquid or air. Patterson et al. '025 teaches that a cushion used in cushioning the heel of a user's foot while in a shoe can be made of a bladder-like material that contains air, gel, or any fluid to aid in distributing the impact forces of the user's foot with the ground. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made, to make the inner member of the reference as applied to claim 1 above out of a bladder containing air, liquid, or gel, as taught by Patterson et al. '0'5, to aid in cushioning the impact of the user's foot with the ground and to better distribute the impact over the user's foot during the gait cycle.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Lenniham, Jr. 5,875,568. The reference as applied to claim 1 above discloses all the limitations of the claim except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lenniham, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that

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smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42).

This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of the reference as applied to claim 1 above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

14. Claims 47, 49-59, 61-65 and 67-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Turner Des. 417,946. Tomat '251 discloses all the limitations substantially as claimed including the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2). Tomat '251 does not teach the use of grooves and ridges. Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer

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sole (as seen in Figure 3, the ride up the side of the sole) and extend to the edges of the outer sole.

Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

15. Claims 60, 66, 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Tomat 6,092,251 in view of Turner Des. 417,946 as applied above further in view of Lennihan, Jr. 5,875,568. Tomat '251 in view of Turner '946 discloses substantially all the limitations of the claims as noted above except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of Tomat '251 in view of Turner '946 as applied above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

16. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Turner Des. 417,946 and Lennihan, Jr. 5,875,568. Tomat '251 discloses the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for



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cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2). Tomat '251 does not teach the use of grooves and ridges or the smooth transition of the back wall of the outer member from a horizontal plane to a vertical plane.

Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer sole (as seen in Figure 3, the ridge up the side of the sole) and extend to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of Tomat '251 in view of Turner '946 as applied above rounded so that it smoothly transitioned between a horizontal plane

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and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

17. Claim 76 is rejected under 35 U.S.C. 103(a) as being obvious over Tomat 6,092,251 as applied to claim 1 above. Tomat '251 as applied to claim 1 above discloses all the limitations of the claim except for the inner member being a softer durometer than the intermediate member. It is well-known in the art of feet cushions that the area of greatest impact, i.e. the heel area, should be made of a softer material than the other cushioning areas since it take the brunt of the impact of the user's foot. This would allow for appropriate cushioning of the heel without impacting the other areas of the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the heel member of Tomat '251 softer than the intermediate member to allow for better cushioning of the heel without detracting from support of the arch and metatarsal areas of the foot.

### *Conclusion*

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read "Anthony D Stashick". The signature is fluid and cursive, with the first name "Anthony" and last name "Stashick" clearly distinguishable.

Anthony D Stashick  
Examiner  
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ADS  
June 2, 2001